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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,117	07/11/2003	Caroline Sassano Slone	06147D USA	4103

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EXAMINER

METZMAIER, DANIEL S

ART UNIT PAPER NUMBER

1712

DATE MAILED: 09/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/618,117

Applicant(s)

SLONE ET AL.

Examiner

Daniel S. Metzmaier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13,14,18 and 24-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13,14 and 18 is/are allowed.
- 6) ☒ Claim(s) 24-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Claims 13-14, 18 and 24-29 are pending.

Terminal Disclaimer

1. The terminal disclaimer filed on July 3, 2006 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of any patent issuing on U.S. Application 10/112,537 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

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not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claim 27 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Schäfer-Burkhard, US 4,311,618. Example 5 of the reference discloses the claimed incorporation of the claimed compounds in an aqueous cleansing composition. The foam control function would have been inherent to the compound disclosed in the Schäfer-Burkhard reference. A compound and all of its properties are generally inseparable. See *In re Papsech*, 315 F2d. 381, 137 USPQ 43, (CCPA 1963).

To the extent the Schäfer-Burkhard reference employs the HCl salt rather than the non-salt form of the compound per se, the salt form is a conventional form of adding the compounds of the claims for water solubility and dispersibility, which is the intended system being utilized instantly and in the prior art.

Furthermore, claim 27 sets forth the alkyl glycidyl ether-capped polyamines, which one skilled in the art would have expected to have basic amino groups and 0.01 to 20 wt% of a water-soluble inorganic acid, i.e., HCl. Said acid and the alkyl glycidyl ether-capped polyamine would have been expected to form the salt in acidic aqueous media, which the claim reads. The claimed subject matter reads on the Schäfer-Burkhard salts.

To the extent the Schäfer-Burkhard reference differs regarding the use of the compounds as foam control agents or the use of the salt, the foam control properties in

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water-borne systems would have been expected to be the same or to vary slightly with the hydrophobicity of the agents employed. Applicants have provided no evidence that the salt form or the particular compounds employed would have been critical to the inventive compositions.

6. Claims 24-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lassila et al, US 5,939,476, in view of Takemoto Yushi KK, JP S52-10847 (Translation provided by applicants, see IDS file July 11, 2003).

Lassila et al '476 disclose (column 5-6 and claims 16-18) typical compositions including organic coating, ink, and agricultural compositions employing 0.01, 0.01 or 0.1 wt%, respectively, of an alkylated polyamine wetting agent. Lassila et al '476 (column 2, lines 58 et seq) recognizes the prior art use of related alkylated polyamines having antimicrobial properties.

Lassila et al '476 differs from the instant claims in the incorporation of the alkyl glycidyl ether-capped polyamine.

Takemoto Yushi KK, JP S52-10847, (Translation) disclose methods of making alkyl glycidyl ether-capped polyamine compounds having antimicrobial or bactericidal properties for addition to aqueous systems, such as bouillon culture medium (page 10, translation) to mitigate bacterial or mold growth.

These references are combinable because they teach related polyamine compounds recognized in the art for their bactericidal properties. It would have been obvious to one of ordinary skilled in the art at the time of applicants' invention to employ the bactericides of Takemoto Yushi KK, JP S52-10847, in the compositions of Lassila et

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al '476 as a antimicrobial for the advantage of mitigating microbial growth in aqueous compositions specifically provided for in the organic coating compositions.

One having ordinary skill in the art at the time of applicants' invention would have reasonably expected the addition of the agents taught in the Takemoto Yushi KK, JP S52-10847, reference to mitigate growth of bacteria and/or mold in the aqueous compositions of Lassila et al '476, which as aqueous compositions containing organic resins, thickeners, stabilizers, and/or surfactants would have been prone to mold and/or bacterial degradation upon lengthy storage. The defoaming properties recited in the instant claims would have been expected to have been inherent to the bactericidal compounds disclosed in the Takemoto Yushi KK, JP S52-10847, reference. A compound and all of its properties are generally inseparable. *In re Papsech*, 315 F2d. 381, 137 USPQ 43, (CCPA 1963).

The overprint varnish and adhesive is a organic coating composition as disclosed in the Lassila et al '476 reference. The fountain solution is an ink composition for planographic printing (see Table at instant page 11).

Allowable Subject Matter

7. Claims 13-14 and 18 are allowed.

Response to Arguments

8. Applicant's arguments filed July 3, 2006 have been fully considered but they are not persuasive.
9. The above issues remain in the instant application.

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10. Applicants (pages 8 and 9) assert claim 27 has been amended to Jepson claim format and thus obviates the anticipation rejection over the US '618 reference. This has not been deemed persuasive since the purpose of adding the defoaming compounds are not probative to a otherwise anticipated composition. Since the compositions are the same and employ the claimed components in the claimed concentrations, the reasons of adding any particular component or the advantage resulting in the formation of a known composition are not probative.

Applicants do not refute the facts that the US '618 reference employs each of the claimed components in the claimed concentrations for claim 27.

Furthermore, applicants provide an article entitled , "The Function of Fountain Solution in Lithography", which includes as fountain solution functions, cleaner, spreading, and wetting. Applicants have not shown or provided probative reasons why the compositions of the US '618 reference would be excluded or are distinguished by the compositions as claimed.

11. Applicants (page 10) assert the examiner's rejection and conclusions of obviousness in the rejection of Lassila et al, US 5,939,476, in view of Takemoto Yushi KK, JP S52-10847 (Translation provided by applicants, see IDS file July 11, 2003) is based on speculation. This has not been deemed persuasive for the following reasons. Initially, the Lassila et al reference (column 2, lines 58 et seq) teaches the compounds of related structure and surface activity have antimicrobial properties and are employed in substantially the same compositions.

Furthermore, Lassila et al (column 6) teaches that typical aqueous organic coating compositions employ antimicrobials. It is well known in formulating aqueous compositions employing organic components that may be subject to microbial degradation to incorporate minor amounts of antimicrobial agents and said premise is clearly suggested in column 6 of the Lassila et al reference use in typical coating compositions.

It is further pointed out that structurally similar compounds are generally expected to have similar properties. *In re Gyurik*, 596 F.2d 1012, 201 USPQ 552 (CCPA 1979). In the instant case, the Lassila et al reference teaches structurally related compounds are known to have antimicrobial properties and are taught as surface active agents in aqueous compositions closely related to those instantly claimed. By analogy, the compounds taught in Takemoto Yushi KK as antimicrobial materials and being structurally similar to those disclosed in the Lassila et al reference would function similar and have been obvious additions to the compositions disclosed in the Lassila et al reference.

Furthermore, "The reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem." "It is clear that while there must be motivation to make the claimed invention, there is no requirement that the prior art provide the same reason as the applicant to make the claimed invention." See MPEP 2144.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S. Metzmaier whose telephone number is (571) 272-1089. The examiner can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy P. Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Daniel S. Metzmaier
Primary Examiner
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DSM